

AFT 2711

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

1 Application Serial No. 08/902,005
2 Filing Date 7/29/1997
3 Inventorship Butler et al.
4 Group Art Unit 2711
5 Examiner Tran, H.
Applicant Microsoft Corporation
6 Attorney's Docket No. MS1-119US
Title: Providing Enhanced Content With Broadcast Video

TRANSMITTAL LETTER AND CERTIFICATE OF MAILING

7 To: The Commissioner of Patents & Trademarks
8 Washington, D.C. 20231
9 From: Lance R. Sadler (Tel. 509-324-9256; Fax 509-323-8979)
10 Lee & Hayes, PLLC
421 W. Riverside Avenue, Suite 500
11 Spokane, WA 99201

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12 The following enumerated items accompany this transmittal letter and are being submitted for the
13 matter identified in the above caption.

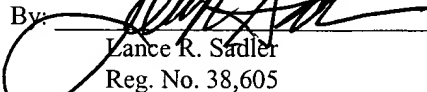
- 14 1. Transmittal letter including Certificate of Mailing
- 15 2. Response to Office Action dated December 19, 2000
- 16 3. Return Post Card

17 Large Entity Status [x] Small Entity Status []

18 *Applicant hereby requests an extension of time in any case such an extension is necessary. The fee
19 should be charged to the Deposit Account indicated below.*

20 The Commissioner is hereby authorized to charge payment of fees or credit overpayments to Deposit
21 Account No. 12-0769 in connection with any patent application filing fees under 37 CFR 1.16, and any
22 processing fees, including any necessary extension fees under 37 CFR 1.17.

Date: 3/19/01

By: 
Lance R. Sadler
Reg. No. 38,605

CERTIFICATE OF MAILING

23 I hereby certify that the items listed above as enclosed are being deposited with the U.S. Postal
24 Service as first class mail in an envelope addressed to The Commissioner of Patents & Trademarks,
25 Washington, D.C. 20231, on the below-indicated date

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By: 
Dana L. Calhoun

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Inventorship Butler et al.
Applicant Microsoft Corporation
Group Art Unit2711
Examiner Tran, H.
Attorney's Docket No. MS1-119US
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RESPONSE TO OFFICE ACTION DATED DECEMBER 19, 2000

To: Commissioner of Patents and Trademarks
Washington, D.C. 20231

From: Lance R. Sadler (Tel. 509-324-9256; Fax 509-323-8979)
Lee & Hayes, PLLC
421 W. Riverside Avenue, Suite 500
Spokane, WA 99201

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REMARKS

Claims 1-50 remain in the application for consideration. In view of the following remarks, Applicant respectfully requests reconsideration and withdrawal of the present rejections.

Section §103 Rejections

Claims 1-6, 11-15, and 40-43 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,818,441 to Throckmorton et al. (hereafter "Throckmorton"), in view of U.S. Patent No. 6,058,430 to Kaplan (hereinafter "Kaplan"). Claims 7-10, 16-39 and 44-50 stand rejected under §103 over Throckmorton in view of Kaplan and U.S. Patent No. 5,621,428 to King (hereinafter "King").

1 For the reasons set forth below, the Office's §103 rejections are improper
2 and must be withdrawn.

3 4 The Standard for §103 Rejections

5 In making out a §103 rejection, there must be *evidence* of a suggestion,
6 teaching, or motivation to combine the references. *In re Dembiczak*, 50 USPQ2d
7 1614, 1617. Combining the prior art references without evidence of such as
8 suggestion, teaching, or motivation simply takes the inventor's disclosure as a
9 blueprint for piecing together the prior art to defeat patentability—the essence of
10 hindsight. *Id.* The evidence may flow from the prior art references themselves,
11 the knowledge of one of ordinary skill in the art, or, in some cases, from the nature
12 of the problem to be solved. *Id.* The showing, however, ***must be clear and***
13 ***particular.*** *Id.* Broad conclusory statements regarding the teaching of multiple
14 references, standing alone, are not “evidence.” *Id.*

15 16 Discussion of the References

17 As a preliminary matter, in making out the §103 rejections, the Office notes
18 that Throckmorton does not specifically disclose or teach supplemental data files
19 having instructions for rendering a hyperlink overlay on the video stream.
20 Applicant agrees. In point of fact, Throckmorton teaches directly away from any
21 such notion be specifically teaching that “associated data” (i.e. analogous in some
22 respects to Applicant's recited supplemental data) can be received with the
23 primary data (i.e. the live or pre-recorded program information) and stored in
24 memory for “future use”. See, e.g. column 4, lines 25-28. Accordingly, not only
25 does Throckmorton *not* teach, hint, or suggest that any such associated data is ever

1 displayed on or overlaid with the primary data for user viewing, it teaches directly
2 away from this notion.

3 In making out the §103 rejections, the Office relies on Kaplan (citing to
4 Kaplan's column 5, lines 1-6), and argues that Kaplan teaches "including
5 instructions for rendering a hyperlink overlay on the video stream." See, e.g.
6 Office Action dated 12/19/00, page 3, first paragraph.

7 Applicant respectfully disagrees and submits that the Office has
8 misinterpreted Kaplan. Specifically, Kaplan discloses a system that transmits a
9 program, for example a television program, and encodes and transmits an Internet
10 address associated with the program in the Vertical Blanking Interval. See,
11 column 2, lines 1-7; column 4, lines 35-41. The Internet addresses that are
12 transmitted relate to the program, content of the program, or commercial broadcast
13 on the incoming signal. See, column 2, lines 59-61. A processor 22 (see, e.g.,
14 Kaplan's Fig. 1) decodes the URL Internet address and transmits the URL to
15 another processor in an Internet subsystem 12 which checks to see whether the
16 URL is a valid address. If the address is a valid address, Kaplan's system simply
17 *signals* that a valid address has been received. Specifically, Kaplan sets forth in
18 column 5, lines 1-13:

19
20 If it [i.e. the URL] is [a valid address], the processor
21 (40) instructs the graphic display controller (46) to signal that
22 a valid URL Internet address had been received. The graphic
23 display controller (46) is also interfaced with the video
24 amplifier such that its graphics can be overlaid on the video
25 image projected to the picture tube. The graphic display
controller (46) can place an information symbol, icon or text
message on the screen indicating that the processor (40) has
received an Internet address. In another embodiment of the
present invention, external lights such as light emitting diodes

1 (LED's) can be used to signal the user that a valid URL has
2 been received. These LED's most typically will be
3 incorporated into the housing of the television.

4 Kaplan's system is essentially just a signaling system that signals a user
5 that a valid URL has been received. It does this by using an information symbol,
6 icon, or text message on the television screen. These graphics are presumably
7 rendered in the same way that closed caption graphics are rendered. See, e.g.
8 Kaplan, column 4, lines 53-61, which states, "[t]he OSD processor (22) is also
9 connected to the tuner (20) such that it can receive the VBI portion of the
10 incoming RF signal (50). The OSD processor (22) decodes the information
11 embedded in the VBI. In all modern televisions, this includes the closed
12 captioning information in scan line 21. In the present invention, the OSD
13 processor (22) will also decode embedded URL Internet addresses and related
14 information embedded in one or more of the scan lines 10 through 20." This is not
15 a hyperlink overlay as completed in Applicant's claims and described in
16 Applicant's specification. Rather, Kaplan simply renders a symbol of some sort
17 on the screen to indicate that a valid URL has been received.

18 Nowhere does Kaplan disclose or suggest including instructions for
19 rendering a hyperlink overlay on a video stream. Accordingly, the Office has
20 misinterpreted Kaplan and ascribed to it properties that it simply does not have.

21 Thus, the following can be said of Throckmorton and Kaplan:

- 22 1. Throckmorton does not teach, hint, or suggest that any such
23 associated data is ever displayed on or overlaid with the primary data
24 for user viewing. In fact it teaches directly away from this notion as
25 pointed out above;
2. Kaplan does not disclose or suggest including instructions for
rendering a hyperlink overlay on a video stream.

1 There simply is no *clear and particular* teaching in any of these references,
2 as there must be, that would lead one of ordinary skill in the art to combine the
3 references to render the subject matter of the claims discussed below obvious.

4
5 **Discussion of the Claims**

6 **Claim 1** recites a method directed to transmitting supplemental data files
7 along with a video stream. The supplemental data files are formatted “in a
8 graphical markup language”, each having instructions for “rendering a hyperlink
9 overlay on the video stream.”

10 None of the references cited by the Office disclose or suggest the subject
11 matter of claim 1. Accordingly, claim 1 is allowable.

12 **Claims 2-15** depend either directly or indirectly from claim 1, and are
13 allowable as depending from an allowable base claim. These claims are also
14 allowable for their own recited features which, in combination with those recited
15 in claim 1, are neither shown nor suggested by the references of record.

16 **Claim 16** recites a method for rendering hyperlink pages on a video stream
17 and specifically recites “formatting HTML files having instructions for rendering
18 hyperlink pages on a video stream.” None of the references cited by the Office, as
19 pointed out above, disclose or suggest this feature. Accordingly, this claim is
20 allowable.

21 **Claims 17-23** depend from claim 16 and are allowable as depending from
22 an allowable base claim. These claims are also allowable for their own recited
23 features which, in combination with those recited in claim 16, are neither shown
24 nor suggested by any of the references of record, either singly or in combination
25 with one another.

1 **Claim 24** recites a method in which a video stream is received. One or
2 more hyperlink pages are associated with the video stream and have transparent
3 areas that are set to a key color. The hyperlink pages are displayed on a display.
4 The video stream is displayed on the display in areas of displayed hyperlink pages
5 that are set to a key color. Thus, this method recites displaying a video stream
6 within areas of a hyperlink page. Nowhere do any of the references cited by the
7 Office disclose or suggest any such method. Accordingly, claim 24 is allowable.

8 **Claims 25-31** depend from claim 24 and are allowable as depending from
9 an allowable base claim. These claims are also allowable for their own recited
10 features which, in combination with those recited in claim 24, are neither shown
11 nor suggested by the references of record, either singly or in combination with one
12 another.

13 **Claim 32** is directed to a computer-readable storage medium having
14 instructions for performing steps that are the same as those set forth in claim 24.
15 For all of the reasons set forth above with respect to the patentability of claim 24,
16 this claim is allowable.

17 **Claims 33-39** depend from claim 32 and are allowable as depending from
18 an allowable base claim. These claims are also allowable for their own recited
19 features which, in combination with those recited in claim 32, are neither shown
20 nor suggested by the references of record, either singly or in combination with one
21 another.

22 **Claims 40-43** recite a video broadcast system. Claim 40 specifically
23 recites "a broadcast source that broadcasts a video stream and provides
24 accompanying supplemental data files, each supplemental data file having
25 instructions for rendering a hyperlink overlay on the video stream; [and] a

1 receiver configured to receive the video stream and accompanying supplemental
2 data files and to display the hyperlink overlays in conjunction with the video
3 stream.” Nowhere do any of the references cited by the Office disclose or suggest
4 a broadcast system in which a broadcast source provides a video stream and
5 accompanying supplemental data files each of which have instructions for
6 rendering a hyperlink overlay “on” the video stream. Rather, as pointed out
7 above, the references fall far short of teaching or suggesting the claimed subject
8 matter. Accordingly, claim 40 is allowable.

9 **Claims 41-44** depend from claim 40 and are allowable as depending from
10 an allowable base claim. These claims are also allowable for their own recited
11 features which, in combination with those recited in claim 40, are neither shown
12 nor suggested by the references of record. Accordingly, these claims are
13 allowable.

14 **Claim 45** recites a receiver for receiving and displaying video streams. The
15 claim recites display hardware for displaying video streams and bit-mapped
16 images to a user. The display hardware is recited to include color keying
17 hardware that displays video in display areas that are set to a key color. Access
18 means are recited for reading supplemental data files that have instructions for
19 rendering bit-mapped hyperlink overlays in conjunction with the video stream at
20 indicated times. A data processor is recited to read the supplemental data files and
21 in response display the hyperlink overlays at the indicated times. The hyperlink
22 overlays have transparent areas that are set to a key color thus appearing to overlay
23 the video streams. As pointed out above, none of the references cited by the
24 Office disclose or suggest any such system in which any hyperlink overlays appear
25 to overlay a video stream. Accordingly, this claim is allowable.

1 **Claims 46-50** depend from claim 45 and are allowable as depending from
2 an allowable base claim. These claims are also allowable for their own recited
3 features which, in combination with those recited in claim 45, are neither shown
4 nor suggested by the references of record, either singly or in combination with one
5 another.

6
7 **Conclusion**

8 Applicant submits that all of the claims are in condition for allowance and
9 respectfully requests a Notice of Allowability be issued forthwith. If the Office's
10 next anticipated action is to be anything other than issuance of a Notice of
11 Allowability, Applicant respectfully request that the undersigned be contacted for
12 the purpose of scheduling an interview.

13
14 Respectfully Submitted,

15
16 Dated: 3/19/01

17 By: 

18 Lance R. Sadler
19 Reg. No. 38,605
20 (509) 324-9256
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